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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,034	03/25/2004	Robert Allan Young	PUS-P001-041	5815
35246 7590 07/26/2007 MOETTELI & ASSOCIES SARL CASE POSTALE 486 GENEVA, CH-1211 SWITZERLAND				
			EXAMINER SHAFFER, RICHARD R	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 07/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/809,034

**Applicant(s)**

YOUNG ET AL.

**Examiner**

Richard R. Shaffer

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-9 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9 and 11-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/10/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 5-9, 11-13 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites "securing a joint portion to a long portion of an osteotomically separated long bone" and "the offset equal to less than the sum of the radii of each such adjacent overlapping holes yet more than a radius of a larger such overlapping holes." Applicant does not have support in the specification as originally filed for such language. There is no inherency that there will be a joint portion nor a long portion that are separated (an osteotomy could merely mean a hole or a wedge cut out). Further, while applicant has support for overlapping holes having an offset of a given distance with a necked down portion between the overlapping holes, there is no support in defining the offset by the radii of the holes especially when there has been no definition of what the offset is measuring between (i.e. two central points or nearest edges). Claim 7 also suffers from the second limitation not supported by the specification as originally filed. Claims dependent upon claims 1 or 7 are rejected for being dependent upon a non-enabled base claim.

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### ***Specification***

The amendments to the specification are objected to for the reasons set forth in the 35 U.S.C. 112, first paragraph rejection detailing the "osteotomically separated", "long portion", "joint portion", as well as the description of the offset defined by the radii of the holes.

### ***Drawings***

The amended drawing filed on May 10<sup>th</sup>, 2007 is acknowledged and accepted by the examiner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-9, 11-14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver et al (US Patent 6,623,486) in view of Steffee (US Patent 4,611,581).

Weaver et al disclose a bone plate (**Figures 7, 8 and 10**) with at least two axes with bone screw receiving holes comprising: threaded holes (**58 and 56a**) having wide bevels; countersunk round hole (**56b, Figures 12-16**) with the countersunk is approximately 25 degrees; a locking bone peg (**20, Figure 2**) with a threaded head (**22**) and unthreaded body (immediately below threaded head portion); the distance between two sets overlapping holes is approximately 15 mm due to the plate being for the femur,

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anatomical constraints in design, that several different overlapping holes could be used to meet the limitation, and the use of approximately is broad enough to encompass many other values; a bone screw (**10, Figure 1**).

Weaver et al fail to disclose threaded overlapping holes having an offset of a given distance with a necked down portion therebetween. Steffee teaches (**Figure 9; Column 4, Lines 54-65; and Column 5, Lines 50-60**) that slots (**52**) allow for ease of locating of a fixation element and that overlapping holes (**116**) keep the fastener for displacing along the hole. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form scalloped slots (overlapping fixation holes) to increase the locations a surgeon can insert a bone screw or bone peg while maintaining the axial location of the fixation element relative to the plate.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver et al in view of Steffee and in further view of Cesarone (5,851,207). Weaver et al in view of Steffee disclose all of the claimed limitations except is silent as to a drill guide being used in combination which engages the holes of the bone plate to stabilize a drill. Cesarone teaches (**Column 1, Lines 14-37**) that using a drill guide minimizes misalignments and cause improperly secured plates. The drill guide (**Figure 1**) connects to the bone plate and ensures an orientation appropriate for a later bone screw. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to consider using the drill guide of Cesarone to accurately tap holes to be used for a non-threaded shaft, threaded head screw to correctly implant the screw and to secure the bone plate properly.

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***Response to Arguments***

Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Richard Shaffer  
July 22<sup>nd</sup>, 2007



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER